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**Datasheet for the decision
of 7 April 2009**

Case Number: T 0775/07 - 3.2.04

Application Number: 97905972.2

Publication Number: 0880331

IPC: A47K 10/36

Language of the proceedings: EN

Title of invention:

Hands-free paper towel dispensers

Patentee:

Wausau Paper Towel & Tissue, LLC

Opponents:

SCA Hygiene Products AB
Ille Papier-Service GmbH
KIMBERLY-CLARK WORLDWIDE, INC.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

EPC R. 115(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Deleting a feature ("Essentiality test")"

"Requiring a real modification of the other features to
compensate for the change"

"Compliance with Article 123(2) EPC (no)"

Decisions cited:

T 0331/87, T 0938/95, T 1067/97, T 0962/98

Catchword:

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Case Number: T 0775/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 7 April 2009

Appellant: Wausau Paper Towel & Tissue, LLC
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 9 March 2007 revoking European patent No. 0880331 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
C. Heath

Summary of Facts and Submissions

- I. By its decision dated 9 March 2007 the Opposition Division revoked the European patent 0 880 331. On 9 May 2007 the Appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 6 July 2007.
- II. The patent was opposed on the grounds based on Article 100(a) and (c) EPC 1973. The Opposition Division considered that neither the claims as granted, nor the claims of the auxiliary requests 1 to 3 complied with the requirements of Article 123(2) EPC.
- III. Oral proceedings took place on 7 April 2009 before the Board of Appeal. As already announced in a letter dated 9 March 2009, Respondent III (opponent III) did not attend the oral proceedings which according to Rule 115(2) EPC were continued without that party.

The Appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution, should either the main request (patent as granted) or auxiliary request four filed with letter dated 6 March 2009 be found to comply with the requirements of Article 123(2) EPC (Article 100(c) EPC 1973). All other requests were withdrawn.

He mainly argued as follows:

The feature "solar panel" is not necessary for carrying out the invention in the light of the problem to be solved which is to avoid jamming and thus cannot be

essential. Furthermore a feature may be inessential even if it was incidentally but consistently presented in combination with other features of the invention. Since the dispenser is already equipped with a battery, it would be self-evident for a skilled person that the control circuitry could be powered by this battery instead of being powered by the solar panel. Removal of the solar panel does not imply any real modification of the control circuitry since the dispenser could function without any on-off switch and the reference voltage must not necessarily be provided by the solar panel.

Additionally, the problem the invention seeks to solve is to avoid jamming and not how to supply energy to the control circuitry. Thus, the solar panel does not contribute to solving the problem of avoiding jamming, accordingly no structural and no functional relationship between the solar panel and the control circuitry is required in order to solve the posed problem.

The Respondents I to III (opponents I to III) contested the arguments of the Appellant. They mainly submitted that deletion of a feature is only allowable when the three criteria set out in decision T 331/87 (OJ OEB 1991, 022) are fulfilled. In the present case none of these criteria is fulfilled. The presence of a solar panel is presented throughout the original disclosure as an essential feature of the invention. It is indispensable for the function of the invention in the light of the technical problem it is meant to solve, and its removal requires real modifications of the control circuitry to compensate for the change.

More specifically, removing the solar panel would deprive the dispenser of the on-off switch, so that it

would remain switched on in the dark. Moreover, the solar panel also provides the voltage reference representative of the ambient light for the photo sensor of the triggering means. Removing it would therefore necessitate some other means in order for the control circuitry to work properly.

Even if the problem to be solved by the invention should be solely seen in the avoidance of jamming, the solar panel would still be part of the solution as presented in the original application. Indeed, there is a functional and a structural relationship between the solar panel and the control circuitry.

The Respondents I to III requested that the appeal be dismissed.

V. Claims 1 as granted reads as follows:

"1. A hands-free towel dispenser (10) comprising:
(a) a housing (12) means for containing towels;
(b) a sensing means (82) for detecting an object;
(c) a dispensing means for dispensing a pre-determined length of towel when said sensing means detects the object, the dispensing means including a drive roller (32) and a motor (88) in driving arrangement with the drive roller (32);
(d) an electric power source for powering said dispensing means;
(e) control circuitry (98) controlling operation of the dispenser (10), wherein the control circuitry (98) is structured to turn off the motor (88) when towel is jammed inside the dispenser (10); to provide a delay

between cycles of towel dispensing and to control the pre-determined length of towel."

Claim 1 of the fourth auxiliary request differs from claim 1 as granted in that feature (e) has been modified by adding the expressions "it is sensed" and "sense and" to read:

"... the control circuitry (98) is structured to turn off the motor (88) when it is sensed towel is jammed inside the dispenser (10) ... and to sense and control the pre-determined length of towel."

Reasons for the Decision

1. The appeal is admissible.
2. *Removal of the feature "solar panel":*
 - 2.1 In the present case, the feature that the hands-free towel dispenser comprises "a solar panel for energising said control circuitry" (feature f)) has been removed from claim 1 as originally filed.

An amendment that deletes a feature from an independent claim is only allowable if the skilled person would directly and unambiguously recognise that

- i) the feature in question was not explained as essential to the invention,
- ii) the feature is not indispensable for the function of the invention in the light of the technical problem it serves to solve, and
- iii) replacement or removal requires no real modification of other features to compensate for the

change (Guidelines for Examination, C-VI, 5.3.10 and decision T 331/87 (OJ OEB 1991, 022)).

In the present case at least the third criterion is not fulfilled.

- 2.2 As described in the application as filed (WO-A-97/29671) the solar panel is utilised for energising the control circuitry (page 5, line 13). No other alternative power source for energising the control circuitry is disclosed in the application as filed. The removal of feature f) i.e. the solar panel for energising the control circuitry from claim 1 as originally filed requires modification of the feature d) (an electric power source for powering said dispensing means) since in that case the electric power source should also be used in place of the solar panel for energising the control circuitry.

The Appellant argued that a battery is already provided for powering the dispensing means, i.e. the motor of the dispenser (page 10, lines 6 to 13) and that it would therefore be obvious for a skilled person that this battery could serve as an alternative power supply for the control circuitry.

However, only what is directly and unambiguously derivable from the originally filed application, taking into account matter which is implicit (not merely obvious) to a skilled person can serve as a basis for an amendment. In the case of a battery used to power the dispenser, it is not implicitly disclosed that the battery is also used to energise the control circuitry, since no other alternative power than the solar panel is disclosed in the application as originally filed.

Nor would such an interpretation be unambiguously derivable for the person skilled in the art.

- 2.3 Moreover, in the application as filed it is stated that "the solar panel functions as an on-off switch for the dispenser and therefore prevents the battery 90 from becoming unnecessarily discharged when the lights are off" (page 11, lines 6 to 9) and further that it is used to adjust the reference voltage in accordance with the ambient light in the room, which reference voltage is compared to the signal of a photo sensor to trigger the dispenser (motor) when a person's hand comes within a given range from the sensor (page 13, line 11 to page 14, line 3). Accordingly, if there is no solar panel, the reference voltage has to be provided according to the ambient light level by a different means. This clearly necessitates compensating for the solar panel by modifying the control circuitry and thus feature e).

The Appellant contended that the dispenser could function without an on-off switch, that the problem to be solved is to avoid jamming and that how the control circuitry triggers the dispensing means is another issue, which is irrelevant for the problem to be solved by the invention.

The Board cannot agree to this line of argument. A control circuitry without an on-off switch might be operable, it is however not directly and unambiguously derivable from the application as filed that the invention also contemplates using such a control circuitry (i.e. which remains switched on in the dark). Furthermore, to deliver a length of towel, the control circuitry triggers the motor to rotate a drive roller. A

roller sensing circuit stops the motor when the roller has made one full turn. This takes a determined time (page 14, line 23 to page 15, line 22). If the one full turn is not performed within a given period of time, jam is supposed to have occurred and a safety timer circuit turns the motor off (page 15, lines 22 to 24). Thus, the jam occurrence control circuit is part of the motor triggering circuit of the control circuitry.

Consequently, how the control circuit triggers the motor is related to the jamming problem. Since the solar panel is also part of the triggering circuit in that it delivers the reference voltage to the circuit, there is a structural and functional relationship between the solar panel and the control circuit in order to solve the jamming problem.

- 2.4 Additionally, the control circuitry has been disclosed in the original application only together with the solar panel. However, if from the original application it is derivable that there is a clearly recognisable functional (or structural) relationship (or both) between these features, it amounts an unallowable amendment to isolate one feature (control circuitry) from its combination with the other feature (solar panel) (see T 1067/97 and T 938/95).

The Appellant argued that there was no functional or structural relationship between the control circuitry and the solar panel inasmuch as the jamming problem was concerned. He further referred to decision T 962/98 to illustrate that an intermediate generalisation (from solar panel to power supply) could be admissible under Article 123(2) EPC.

The Board cannot agree with this point of view.

In the present case, the subject-matter generated by the amendment from "solar panel" to the more general "power supply" involves added subject-matter, because no other power supply than the solar panel has been originally disclosed for energising the control circuitry. The fact that the control circuitry could be energised by an unspecified power supply is clearly new information which is not directly and unambiguously derivable from the originally filed application.

- 2.5 Accordingly, the removal of the feature "solar panel" in claim 1 of the main request and of the fourth auxiliary request contravenes the requirements of Article 123(2) EPC (Article 100(c) EPC 1973).

Order

For these reasons it is decided that:

The appeal is dismissed

The registrar:

The Chairman:

G. Magouliotis

M. Ceyte